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10/648,790

08/27/2003

Clark Easter

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4372 7590 10/28/2008  
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EXAMINER

NGUYEN, MAIKHANH

ART UNIT

PAPER NUMBER

2176

NOTIFICATION DATE

DELIVERY MODE

10/28/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com  
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|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/648,790 | <b>Applicant(s)</b><br>EASTER ET AL. |  |
|                              | <b>Examiner</b><br>Maikhanh Nguyen   | <b>Art Unit</b><br>2176              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 14- 33, and 47-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14- 33, and 47-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This action is responsive to the RCE filed 08/21/2008.

Claims 1-11, 14 - 33, and 47-48 are currently pending. Claims 1, 4, and 21-23 have been amended. Claims 1, 21, 22, and 33 are independent claims.

### **Request Continuation for Examination**

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed 08/21/2008 has been entered.

### **Claim Rejections - 35 USC § 101**

3. 35 U.S.C. 101 reads as follows:

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

Claims 1-11, 14-20, 21, 33, and 47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The method claim 1 differs from traditional process claims in several respects. For example, the claim does not recite any particular way of implementing the step, nor does it require any machine or apparatus to perform the step. In addition, the method claim does not recite any electrical, chemical, or mechanical acts or results, which are typical in traditional process claims. Finally, the claim does not call for any physical transformation of an article to a different state or thing. While claim 1 performs “selecting”, “assigning”, “prompting”, “varying”, “performing”, “revising”, and “prompting”, it does not require any machine or apparatus to perform the step.

Because the claim is completely untethered from any sort of structure or physical step, it is directed to a disembodied concept. In other words, the claim is nothing but a disembodied abstract idea until it is instantiated in some physical way so as to be limited to a practical application of the idea. For example, claim 1 does not

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specify whether the entity performing the steps of *“selecting”*, *“assigning”*, *“prompting”*, *varying*, *“performing”*, *“revising”*, and *“prompting”* is a computer, a human, or something else.

Accordingly, the claim is so broad that it is directed to the abstract idea itself, rather than a practical implementation of the concept. In addition, the claim is “so abstract and sweeping” that it would “wholly pre-empt” all applications (whether performed by a machine or a human) that are directed to a method for performing *“selecting”*, *“assigning”*, *“prompting”*, *varying*, *“performing”*, *“revising”*, and *“prompting”* steps.

For the same reasons discussed supra with respect to independent method claim 1, the method claims 2-11 and 14-20 fall outside the scope of § 101.

**Regarding independent Claim 21**, the claim recites a “system” comprising *“means for selecting”*, *“means for assigning”*, *“means for prompting”*, *“means for varying”*, *“means for performing”*, *“means for iteratively”*, and *“means for prompting”*. As currently recited the “system” comprises only computer software elements. Thus, the claim is a program per se and does not fall within any of the four enumerated categories of patentable subject matter in section 101.

For the same reasons discussed supra with respect to independent Claim 21, dependent Claim 47 falls outside the scope of § 101.

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**Regarding independent claim 33**, the Examiner notes that a computer usable medium having control logic is directed to statutory subject matter so long as the language of the claim is not supported in the Specification with non-statutory embodiments (i.e., signals, transmission mediums and the like). See *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007) (A claim directed to computer instructions embodied in a signal is not statutory under 35 U.S.C. § 101).

In the present case, Applicant's Specification discloses that the computer usable medium (that includes signal bearing media) is intended to broadly encompass "a propagated signal on a carrier" (Specification, page 20, lines 24 -26). Because Applicant's claims broadly read on signals and other non tangible transmission mediums, the Examiner concludes that independent Claim 33 is directed to non-statutory subject matter.

### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject*

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*matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

*This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).*

Claims 1-11, 14- 33, and 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Roper** (US 6270351) in view of **Morley et al.** (US 2004/0148192) and further in view of **Bates et al.** (US 7398467).

**As to claim 1:**

Roper teaches a method for providing interactive assistance with populating an automated document that includes at least one field (*see Abstract & col. 2, lines 1-35*), the method comprising:

- selecting an entity to which the document applies [*see col.2, lines 1-44 & col.4, lines 32-44*];
- assigning a prioritization to each of the at least one field (*e.g., when a user logs onto the individual education program system, he must enter a login ID and password; col. 8, lines 15-29 & see item StudentID in fig.5*);

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- prompting for a response for each of the at least one field (e.g., *Once the student profile is generated ... prompting the user of the system for certain basic information regarding the student ... includes the student's name, age, birthdate, grade, etc...; col. 6, lines 10-18 & see fig. 7*), the prompting varying based on the prioritization of each of the at least one field (*col.6, lines 1-21*);
- iteratively revising the prioritization of all of the at least one field upon receiving the response to each of the at least one field (e.g., *the system automatically brings up the student's current IEP record ... The next step in the process for editing an existing individual education plan comprises displaying the student's information screen for the current individual education plan on the computer monitor ... Changes in the student information may be made on this screen by the users of the system*) [see the discussion beginning at col.7, line 30]; and
- prompting for a response for at least one field, the prompting varying based on the iteratively revised prioritization of all of the at least one field (e.g., *before an individual education plan may be created, a student profile is created by entering information about the student. The user of the system selects the Enter/Edit Student information option 402 from the main menu 400. Selecting this option brings up a student information*



*screen. Via the student information screen, the user of the system may enter all pertinent information relating to the particular student... records are saved, the individual education program tracking system returns control to the main menu 400... Typically, a state has requirements that must be met before a student can enter a special education plan, such as that provided by an individual education plan. These requirements include an assessment of a student's skills and parental (guardian) authorization. The individual education program tracking system automatically generates the forms for complying with these regulatory requirements. Once the requirements have been met, then an individual education plan may be created for a student) [see the discussion beginning at col.8, line 15].*

Roper, however, does not specifically teach “performing a compliance check for each response for the at least one field to determine if the response complies with predetermined legal requirements.”

Morley teaches performing a compliance check for each response for the at least one field to determine if the response complies with predetermined legal requirements [See the Abstract and ¶¶ 0015 – 0018: perform a compliance rules analysis on the data of the existing Form I-9 document to determine whether the existing Form I-9 document was correctly completed ... complete the Form I-9's associated with a particular employer as identified by performing

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*the compliance rules analysis on the Form I-9 documents associated with a particular employer ... identify both blank fields and inconsistent entries, such as the selection of incompatible document types or the entry of incompatible dates, which cannot be correct].*

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Roper with Morley because it would have managed all of the employment eligibility forms associated with particular employers, to assure continued compliance with federal regulations.

The combination of Roper and Morley does not specifically teach “varying a color of each of the at least one field based on the prioritization.”

Bates teaches varying a color of each of the at least one field based on the prioritization [See fig. 3 and col. 3, lines 18-43: *Each record is associated with a respective WORD field 310, a respective PRIORITY field 320, a respective COLOR field 330 ... The PRIORITY field 320 indicates a priority level ... determine which problem word should receive high priority].*

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Bates with Roper as modified by Morley because

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it would have indicated a priority level for each field in the form and facilitated correction of the fields.

**As to claim 2:**

Roper teaches the document is a form (*e.g., form; col.5, lines 20-25*).

**As to claim 3:**

Roper teaches the form is used for compliance with educational requirements (*e.g., forms required by either or both local school districts and state departments of education; col.2, lines 26-30*).

**As to claim 4:**

Roper teaches the educational requirements include requirements under the Individuals with Disabilities Education Act (*see col.1, lines 16-34*).

**As to claim 5:**

Roper teaches identifying data from an accessible repository responsive to any of the at least one field of the document (*see item StudentID in fig.5*); and automatically populating each of the at least one field of the document for which the responsive data from the accessible repository are identified (*col.9, lines 1-46 and see fig.9*).

**As to claim 6:**

Refer to the discussion of claim 4 above for rejection.

**As to claim 7:**

Roper teaches teach if the compliance check passes, providing an option to lock the document (*see col. 13, lines 1-13 and Fig. 1*).

**As to claim 8:**

Roper teaches receiving a selection of a response to the option to lock the document; and if the selection is to lock the document, preventing revision of each of the responses to the at least one field (*e.g., If the user selects the Lock This IEP option 1710, the system locks the individual education plan record in the individual education program database 18 from any further modifications; col.13, lines 1-13 and see fig.1*).

**As to claim 9:**

Roper teaches prompting a user for security information (*e.g., enter a login ID and password; col.7, lines 15-16*).

**As to claim 10:**

Roper teaches the entity is an individual (*e.g., an individual; see the Abstract*).

**As to claim 11:**

Roper teaches storing the automated document with the response to each of the at least one field (*see figs. 9-11 and associated text*).

**As to claim 14:**

Roper teaches identifying data from an accessible repository responsive to any of the at least one field of the document (*see item StudentID in fig.5*); and automatically populating each of the at least one field of the document for which the responsive data from the accessible repository are identified (*col.9, lines 1-46 and see fig.9*); and highlighting each of the at least one field containing automatic populating (*see figs. 7-8*).

**As to claim 15:**

Roper teaches prompting for a response to one field is selected from, among other things, prompting for an optional response (*e.g., selection of the Enter/Edit Student Information of the main menu; col.6, lines 1-42 & col.7, line 60-col.8, line 14*).

**As to claim 16:**

Roper teaches selecting an entity to which the document applies includes searching a repository containing at least one entity (*col.6, lines 22-58 and see fig.1*).

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**As to claim 17:**

Roper teaches providing an option to select the automated document form a plurality of documents (*col.6, lines 1-42 & col.7, line 60-col.8, line 14*).

**As to claim 18:**

Roper teaches generating the plurality of documents via a search (*col.5, line 59-col.6, line 58*).

**As to claim 19:**

Roper teaches the automated document is associated with a meeting (*col.9, line 47-col.10, line 7 and see fig.12*).

**As to claim 20:**

Roper teaches the meeting includes at least one event (*col.9, line 47-col.10, line 7 and see fig.12*).

**As to claim 21:**

Note the rejection of claim 1 above. Claim 21 is the same as claim 1, except claim 21 is a system claim and claim 1 is a method claim.

**As to claim 22:**

The rejection of claim 21 above is incorporated herein in full. Additionally, Roper teaches a processor (*e.g., computers*); a user interface (*e.g., a user-friendly interface; col.4, line 20*); and a repository (*e.g., a central database*) [see *col.2, lines 54-63 and col.4, lines 1-53*].

**As to claim 23:**

Roper teaches the processor is housed on a terminal (*e.g., a personal computer; col.4, lines 4-5*).

**As to claim 24:**

Roper teaches the terminal is selected from, among other things, a personal computer (*e.g., a personal computer; col.4, lines 4-5*).

**As to claim 25:**

Roper teaches the processor is housed on a server (*e.g., the server 10; col.4, line 3 and see fig.1*).

**As to claim 26:**

Roper teaches the server is selected from, among other things, a personal computer (*e.g., a personal computer; col.4, lines 4-5*).

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**As to claim 27:**

Roper teaches the server is coupled to a network (*e.g., the network; col.4, lines 5-16 and see Fig.1*).

**As to claim 28:**

The use of the Internet is inherent to the system of Roper.

**As to claim 29:**

Roper teaches the server is coupled to the network via a coupling (*col.4, lines 3-16*).

**As to claim 30:**

Roper teaches the coupling is selected from a group consisting of a wired connection, a wireless connection, and a fiberoptic connection (*e.g., see Fig.1 and the accompanying text beginning at col.3, line 63*).

**As to claim 31:**

Roper teaches the repository is housed on a server (*e.g., the server 10; col.4, line 3 and see fig.1*).

**As to claim 32:**

Refer to the discussion of claim 27 above for rejection.



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**As to claim 33:**

Note the rejection of claim 1 above. Claim 33 is the same as claim 1, except claim 33 is a computer program product claim and claim 1 is a method claim.

**As to claims 47-48:**

Refer to the discussion of claim 4 above for rejection.

## **Response to Arguments**

5. Applicant's arguments filed 08/21/2008 have been fully considered but they are not persuasive.

Applicant argues in substance that claim 13 does not recite or mention "signal"  
[Remark, page 10].

The examiner disagrees.

Claim 33 recites a medium, that medium being a signal. Signals are non-statutory subject matter. If Applicant truly believes that Claim 33 defines statutory subject matter as currently recited, then the examiner strongly encourages Applicant to appeal the 101 rejection for Claim 33 to the Board of Patent Appeals and Interferences.

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Applicant argues in substance that Roper does not disclose or suggest the claimed "varying a color of each of the at least one field based on the prioritization" [Remark, page 12].

The new combination of the references - Roper, Morley, and Bates - teaches varying a color of each of the at least one field based on the prioritization [See Bates, Fig. 3 and col. 3, lines 18-43: *Each record is associated with a respective WORD field 310, a respective PRIORITY field 320, a respective COLOR field 330 ... The PRIORITY field 320 indicates a priority*].

### **Conclusion**

6. The prior art made of record, listed on PTO 892 provided to Applicant is considered to have relevancy to the claimed invention. Applicant should review each identified reference carefully before responding to this office action to properly advance the case in light of the prior art.

### **Contact information**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached at (571) 272-4137.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 2176

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